

REMARKS

Claims 1-6, 8-9, and 20-51 stand in the application. Claims 1, 20, 27 and 33 are in independent form.

In the Final Office Action, the Examiner rejected claims 1-6, 8-9, and 20-51 under 35 U.S.C. §103 as being unpatentable over U.S. Pat. App. Pub. 2003/0046447 to Kouperchliak in view of U.S. Pat. App. Pub. 2002/0145632 to Shmueli and U.S. Pat. No. 6,829,672 to Deng.

In this Response, Applicants amend at least independent claims 1, 20, 27, and 33 to emphasize the distinctions over the cited references, either alone or in combination.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Reconsideration is requested. In addition to the above amendments, the Applicants make the following remarks regarding individual issues:

THE APPLICANT'S TIME TO RESPOND

The Final Office Action was mailed on December 17, 2009. The three-month initial deadline for responding without having to pay a penalty fee ended on March 17, 2010. The one-month extended deadline was April 17, 2010, which fell on a Saturday. Accordingly, the one-month extended deadline is April 19, 2010. Applicant submits herewith a one-month extension fee together with a Request for Continued Examination fee.

THE SECTION 103(A) OBVIOUSNESS REJECTION

The Examiner rejected claims 1-6, 8-9, and 20-51 under 35 U.S.C. §103 as being unpatentable over U.S. Pat. App. Pub. 2003/0046447 to Kouperchliak in view of U.S. Pat. App. Pub. 2002/0145632 to Shmueli and U.S. Pat. No. 6,829,672 to Deng under. For at least the following reasons, Applicants traverse the Examiner's rejection. More

specifically, Applicants have articulated their response as an element-by-element discussion of the multiple elements Applicants assert are patentable over the cited prior art.

The standard under Section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In re O'Farrell, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” KSR Int'l v. Teleflex, Inc., 127 S.Ct. 1727, 1742, 167 L.Ed.2d 705 (2007). The Examiner bears the initial burden in the case of Section 103(a) obviousness rejection which requires the Examiner to put forward evidence that the invention as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984), citing In re Warner, 379 F.2d 1011, 1016 (CCPA 1967). Moreover, the Examiner cannot rely on the applicant's disclosure in any way in making this prima facie case. MPEP 2143. The foundational facts for the prima facie case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art. Graham v. John Deere Co., 383 U.S. at 17-18; Miles Lab., Inc. v. Shandon Inc., 27 USPQ2d 1123, 1128 (Fed. Cir. 1993). Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 231, 236 (Fed. Cir. 1983). Each obviousness determination rests on its own facts. In re Durden, 226 USPQ 359, 361 (Fed. Cir. 1985). Where the Examiner relies on a single prior art reference for an obviousness rejection, which does not describe every limitation of the claim, the Examiner must demonstrate how a person of ordinary skill in the art would have been motivated to modify the reference to achieve the invention without the benefit of hindsight, just as with a combination of references.

The Federal Circuit has made clear that under KSR, the examiner must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Innogenetics, N.V. v. Abbott Laboratories, 512 F.3d 1363, 1373, 85 USPQ2d 1641, 1647-48 (Fed. Cir. 2008). The examiner must explain “how or why a person ordinarily skilled in the art would have found the claims of the ...patent

obvious in light of some combination of those [prior art] references.” Innogenetics, 512 F.3d 16 1373. Similarly, the court held after KSR, the prior art must have narrowed down the number of potential solutions before an option is deemed “obvious to try”—it is not sufficient if the prior art discloses a broad selection of options, any one of which could have been selected as a basis for further investigation. Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd., 492 F.3d 1350, 1359, 82 USPQ2d 1169, 1176 (Fed. Cir. 2007).

Although the Supreme Court rejected rigid application of the “suggestion, motivation, teaching test” applied by courts in the past, it can still be a useful starting point for evaluation and to prevent hindsight analysis, so long as it is not applied rigidly and the evaluator maintains the framework of the analysis laid down in Graham v. John Deere Co., 383 U.S. 1 (1966). KSR, 127 S.Ct. at 1242. The requirement to show a teaching or suggestion to combine prior art references to achieve the claimed invention is critical to preventing hindsight-based obviousness analysis. In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000). “Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to ‘fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’” Id at 999 (quoting W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). “[T]he showing must be clear and particular.” Id. Moreover, “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.” Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986).

1. Private memory component

The Examiner acknowledges that neither Kouperchliak nor Shmueli discloses a protected memory component; the Examiner alleges, however, that Deng discloses a protected memory component.

Claim 1 has been amended to recite a private memory component as follows:

. . . a protected memory component storing at least part of a protected software or data that is installable or executable on the host computing device by said user and the protected software or data stored in the protected memory component cannot be viewed or accessed by said user.

Support for the above can be found for example in at least paragraphs [0045], [0046], [0047], [0048], [0049], [0050], [0051], [0052], [0053], and [0054], and FIG. 8 of the as-filed specification.

There are two elements recited above, namely: protected software or data that is installable or executable on the host computing device by said user; and the protected software or data stored in the protected memory component cannot be viewed or accessed by said user.

Neither Shumeli nor Deng teach or suggest protected software or data that is installable or executable on the host computing device by said user and the protected software or data stored in the protected memory component cannot be viewed or accessed by said user.

For example, Shumeli describes authenticating the said user (e.g. with a user password) for protecting the data stored in key 10. Therefore, with a successful authentication of the user, the user gains access to the key and therefore the user gains access to protected data stored in the key 10 (e.g. to view, copy, install, execute, run, etc. by the user). Alternatively, if authentication of said user fails, said user cannot use the key (e.g. to view, copy, install, execute, run, etc. by the user). More specifically, Shumeli paragraph [0011] recites:

. . . the software on the portable device may provide an authentication routine instructing the host computing device to receive authentication indicia from the user via an interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device. As such, a user must be authenticated prior to using the portable device.
(emphasis added)

Accordingly, Shumeli does NOT teach nor suggest protected software or data that is installable or executable on the host computing device by said user and the protected

memory component cannot be viewed or accessed by said user. Instead, Shumeli explicitly teaches that the user has access to protected data to view, copy, install, execute, run, etc. with a successful authentication of the user. Alternatively, with an unsuccessful authentication of the user, the user has no access to the protected data for anything (to view, copy, install, execute, run, etc.). Nothing in Shumeli teaches or suggests protected memory component storing protected software or data that is installable or executable on the host computing device by said user AND that the protected software or data stored in the protected memory component cannot be viewed or accessed by said user.

Deng describes a “write protection” mechanism by setting the hardware “Write Protection” pin (“WP”) “to ground” for protecting the data saved by the user from being modified or erased so that the device cannot be infected by virus (e.g. by preventing the virus from “modifying or erasing” the data saved by the user). A salient portion of Deng recites:

The write protection pin WP has hardware write protection function, that is, it can physically protect the contents of the flash memory from being modified or erased. On the other hand, driver and firmware provide software write protection function for the external storage device. When the WP pin is at the write protection status (WP pin is connected to ground), the firmware notifies this status to the driver and the driver in turn notifies this status to the operating system. As a result, the contents in the flash memory can not be modified or erased and the data saved by the users can be protected. Especially in this case, the external storage device is impossible to be infected by virus.

Deng does not describe anything akin to the “protected data cannot be viewed or accessed by said user.” Instead, Deng describes the protected data being accessible by the user. In particular, Deng emphasizes that the protected data is saved by the user. For the user to save data, the user must have access to the protected data. Accordingly, said user can copy the protected data to the flash memory (e.g. a saving operation by said user includes a copy operation by the user). Further, the user has access to the protected data for viewing in order for the user to save protected data. Following the teaching of Deng, one of ordinary skill in the art will implement a flash memory device in which the protected data is accessible, viewable, and copy-able by

said user so that the protected data can be saved by the user, independent of whether the setting of the WP pin (write protection pin) is set to ground or not. Therefore, Deng cannot be combined with anything to produce “cannot be viewed or accessed by said user” or “cannot be copied by said user” because Deng explicitly teaches the opposite, namely protecting data saved by the user from being erased or modified by for example a virus.

In addition to the above distinction, claim 1 has been further amended to recite:

. . . the integrated circuit flash memory device for enabling said user to run or execute at the host computing device a protected software or data without providing said user means to copy the protected software or data stored in the integrated circuit flash memory device.

Neither Shumeli nor Deng teach or suggest the above element. In Deng, said user has means to copy the protected software or data stored in the integrated circuit flash memory device (e.g., Deng column 6 line 63 “data saved by the users”). In Shumeli said user has means to copy the protected software or data (e.g., Shumeli paragraph [0011] “user must be authenticated”)

Moreover, Claim 1 has been amended to further recite:

. . . whereby the flash memory device enables said user to operate, run or execute protected software or data on the host computing device from the protected memory component without enabling said user means to access, view or copy the protected software or data from the protected memory component of the integrated circuit flash memory device.

Neither Shumeli nor Deng teach or suggest the above element. In Deng, said user has means to access, view, and copy the protected software or data stored in the integrated circuit flash memory device (e.g., Deng column 6 line 63 “data saved by the users”). In Shumeli, said user has means to access, view, and copy the protected software or data (e.g., Shumeli paragraph [0011] “user must be authenticated”)

Furthermore, in addition to the above elements not taught or suggested by Deng or Shumeli, claim 1 has been further amended to recite:

. . . the application launcher software stored on the integrated circuit memory device including

. . . means to access, by the application launcher software, protected software or data from the protected memory component of the integrated circuit flash memory device in dependence of a successful authentication of the application launcher software that run automatically on the host computing device upon activation of the integrated circuit memory device with the host computing device.

Neither Kouperchliak nor Deng discloses or suggests anything akin to “access by the application launcher software protected software or data . . . in dependence of a successful authentication of the application launcher software that run automatically on the host computing device upon activation of the integrated circuit memory device with the host computing device.”

For example, Shumeli does not disclose or teach authentication of the application launcher software that runs automatically on the host computing device. Instead Shumeli explicitly teaches authentication of said user (e.g., Shumeli paragraph [0011] “user must be authenticated”) and not the application launcher. Therefore, following the teaching of Shumeli, one of ordinary skill in the art will authenticate said user and NOT the application launcher software. Accordingly, Shumeli cannot be combined with Kouperchliak nor Deng to teach the above element based to the explicit teaching that requires authentication of the user.

In addition to the distinctions already described above, Claim 1 has still further been further amended to recite:

. . . the application launcher software stored on the integrated circuit memory device including

. . . means to install, execute or run, by the application launcher software, on the host computing device, the protected software or data accessed from the protected memory component of the integrated circuit flash memory device.

The Examiner acknowledges that neither Kouperchliak nor Shmueli discloses a protected memory component; the Examiner alleges, however, that Deng disclose a protected memory component.

Applicants submit that Deng does not describe anything akin to “the application launcher software stored on the integrated circuit memory device including . . . means to install, execute or run, by the application launcher software, on the host computing

device, the protected software or data accessed from the protected memory component of the integrated circuit flash memory device."

For example, Deng does not describe or suggest application launcher software being stored on the integrated circuit memory device. Moreover, Deng does not disclose the subject matter related to the application launcher software stored on the integrated circuit memory device including . . . means to install, execute or run the protected software or data accessed from the protected memory component of the integrated circuit flash memory device. Instead, Deng explicitly teaches an unrelated subject matter from claim 1 and specially, to setting a hardware WP pin (write protection pin) to ground for preventing data saved by the user to be modified or erased for example by a virus.

Each independent claim 20, 27, and 33 has further been amended to include at least an analogous element similar to claim 1. Accordingly, for at least the reasons offered above regarding the private memory, Applicants assert that independent claims 1, 20, 27, and 33 are patentable. All dependent claims depending from independent claims 1, 20, 27, and 33 are patentable at least for depending from a patentable independent claim.

2. Re-enumerates of flash memory device or wireless device

Claim 2 has been amended to recite as follows:

. . . flash memory device is further operable with the host computing device in accordance with a first device interface description for identifying with the host computing device with the first device interface description, and

subsequent to an autorun operation upon plugging the integrated circuit flash memory device to the host computing device and in response to a query,

the flash memory device re-enumerates itself with a second device interface description and identifies to the host computing device with the second device interface description.

Support for the above can be found for example in at least paragraphs [0025]-[0034] and FIG. 3 of the as-filed specification.

Neither Kouperchliak, Deng, nor Shmueli discloses or suggests the above limitation as recited in claim 2 whether taken independently or in combination.

Independent claims 20 and 27 as well as claims 34 has further been amended to include at least an element analogous to “re-enumerates with a second device interface description” as recited claim 2. Accordingly, for at least the reasons offered above, Applicants assert that independent claims 20 and 27 and dependent claim 34 are patentable. All dependent claims depending from independent claims 20 and 27 are patentable at least for depending from a patentable independent claim.

3. Adding wireless interface to the host computing device

Independent claim 27 has been amended to recite the following:

A method for adding wireless interface to a host computing device with an integrated circuit wireless device connectable to a host computing device, the integrated circuit wireless device including a wireless component for adding wireless interface to the host computing device with the wireless component . . .

. . . activating the integrated circuit wireless device for adding wireless interface to the host computing upon connecting the wireless integrated circuit device to an interfacing port of a host computing device;

Support for adding wireless interface to the host computing can be found for example in at least paragraph [0046] and FIG. 6 of the as-filed specification.

The Examiner acknowledges that Kouperchliak does not disclose a wireless component; the Examiner alleges, however, that Shmueli paragraph [0033] discloses a wireless component as follows:

The smart card 10B may be a contact-based or a contactless (wireless) smart card 10B capable of interacting with the host 12... FIG. 2C depicts a wireless communication device 10C, such as a transponder, capable of facilitating wireless communications with the host 12.
(emphasis added)

Shmueli discloses and explicitly teaches that “wireless communication device 10C, such as a transponder, communicates wirelessly with the host 12” and NOT “for adding wireless interface to the host.” Moreover, Shumeli does not disclose “adding wireless interface to the host upon connecting the wireless integrated circuit device to an interfacing port of a host computing device” as recited by claim 27.

Further, Shumeli does not disclose nor suggest that “the integrated circuit wireless device including a wireless component for adding wireless interface to the host

computing device with the wireless component". Instead, Shmueli explicitly teaches that the wireless device 10C such as a transponder is capable of wireless communication with the host and not adding wireless interface to the host computing device with the wireless component. Nothing in Shmueli teaches or suggests "adding wireless interface to the host computing device upon connecting the wireless integrated circuit device to an interfacing port of a host computing device."

In addition to the above limitation, claim 27 further recites:

. . . wherein the integrated circuit wireless device adds wireless interface to the host computing device by enabling said user to install, execute or run the protected data stored in the protected memory component of the integrated circuit wireless device without providing said user means to view, access or copy the protected data stored in the protected memory component of the integrated circuit wireless.

Shmueli does not disclose nor suggest "adds wireless interface to the host computing" (e.g., Shmueli paragraph [0033] "wireless communications with the host 12."). Moreover, Shmueli does not disclose nor suggests "adds wireless interface to the host computing device by enabling said user to install, execute or run the protected data stored in the protected memory component of the integrated circuit wireless device without providing said user means to view, access or copy the protected data".

Independent claim 33 as well as dependent claims 4 and 42 have each been amended to include at least an element analogous to "adding wireless interface to the host" as recited by independent claim 27. Accordingly, for at least the reasons offered above, Applicants assert that independent claims 27 and 33 and dependent claims 4 and 42 are patentable. All dependent claims depending from independent claims 27 and 33 are patentable at least for depending from a patentable independent claim

4. Two or more downstream ports

Claim 32 has been amended to recite the following:

The method of claim 27 in which the integrated circuit wireless device further including

an upstream port for interfacing with the host computing device,
and

two or more downstream ports, the two or more downstream ports having at least one downstream port associated with at least the wireless

component and at least one downstream port associated with the memory component.

Support for above can be found for example in at least paragraph [0035] and FIGS. 4-6 of the as-filed specification.

Applicant submits that neither Kouperchliak nor Deng disclose a wireless component. Moreover, neither Kouperchliak nor Shmueli disclose or suggest “an upstream port for interfacing with the host computing device, and two or more downstream ports, the two or more downstream ports having at least one downstream port associated with at least the wireless component and at least one downstream port associated with the memory component.”

Claims 6, 35, 40, 47, and 51 have each been amended to include at least an element analogous to element recited above by claim 32. Accordingly, Applicants assert that dependent claims 6, 32, 35, 40, 47, and 51 are patentable.

5. External manual switch on the integrated circuit flash drive memory device

Claim 5 has been amended to recite the following:

The integrated circuit flash drive memory device of claim 1 further comprising a user operable external manual switch on the integrated circuit flash drive memory device that is accessible and operable by said user to select from among plural operating states.

Support for the above can be found for example in at least paragraphs [0042]-[0044] and FIGS. 6 and 7 of the as-filed specification.

The Examiner acknowledges that Shmueli does not disclose “a switch;” the Examiner, however, alleges Kouperchliak discloses a “switch.”

Applicant submits that Kouperchliak does not disclose or suggest a user operated external manual switch on the integrated circuit flash drive memory device that is accessible and operable by said user. Instead Kouperchliak discloses an internal switch that is automatic and not accessible and operable by said user. For example, as illustrated by Kouperchliak FIG 2, the functional switch is an internal functional switch and not an external switch on the integrated circuit flash drive memory device that is accessible and operable by said user. Furthermore, Kouperchliak paragraph [0041] emphasizes that the switch is automatic as “[u]pon starting the peripheral device, which

generally occurs when the peripheral device is plugged in, the function switch 36 automatically switches the peripheral device over to the mass storage device emulator.” Accordingly, Applicants assert that nothing in Kouperchliak teaches or suggests an “external manual switch on the on the integrated circuit flash drive memory device” AND that the external manual switch “. . . is accessible and operable by said user.”

Claims 23 and 30 have each been amended to include at least an element analogous to the manual external switch on the integrated circuit flash drive memory device as recited by claim 5. Accordingly, Applicants assert that claims 5, 23, and 30 are patentable.

Additionally, claim 24 has been further amended to recite:

. . . external manual switch allows a user to select from among more than two operating states, one of which includes operation of a wireless component in the integrated circuit drive memory device.

The Examiner acknowledges that Kouperchliak does not disclose a wireless component. Accordingly, Applicants assert that Kouperchliak could not by extension teach or suggest an “external manual switch that allows a user to select from among more than two operating states, one of which includes operation of a wireless component in the integrated circuit drive memory device.”

For at least the foregoing reasons, the Applicants respectfully assert that currently amended independent claims 1, 20, 27, and 33 are patentable as each recites at least an element not taught or suggested by Kouperchliak, Deng, and Shmueli, either alone or in combination. All dependent claims depending from independent claims 1, 20, 27, and 33 are patentable at least for depending from a patentable independent claim.

CONCLUSION

Applicants respectfully request reconsideration and allowance of claims 1-6, 8-9, and 20-51 of the application as amended.

The Examiner is encouraged to telephone the undersigned at (360) 750-9931 if it appears that an additional interview would be helpful in advancing the case. The Applicants respectfully submit that the rejection of the pending claims must be withdrawn, and that this application is in condition for allowance. Such is earnestly requested.

Respectfully submitted,

/Jon C. Real/

JON C. REALI
USPTO Reg. No. 54,391

RYLANDER & ASSOCIATES PC
406 West 12th Street
Vancouver, Washington 98660
(360) 750-9931